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10/055,313	01/23/2002	Chad Stevens	10013604-01	8004

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EXAMINER

OSORIO, RICARDO

ART UNIT PAPER NUMBER

2673

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,313

Applicant(s)

STEVENS ET AL.

Examiner

RICARDO L. OSORIO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9,10 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9,10 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 9, 10, 13, 16, 18, 19, 21, 22, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Comiskey 6,473,072).

Regarding claim 1, Comiskey teaches of a whiteboard apparatus (Fig. 12a, reference character 120, and col. 14, lines 50-53) comprising:
an electronic paper display device (col. 13, lines 58-61); a writing surface (Fig. 12b, reference character 129) arranged in superimposed relationship with the electronic paper display device (col. 14, lines 47-49 and 52-53. Note that the protecting layer or coating is the superimposed writing surface); and a user interface device (col. 16, lines 60-68) for enabling the electronic paper display to present a user with a plurality of reference images (col. 14, lines 47-61 and col. 16, lines 60-64. Any underlying image over which the user may write constitutes a reference image) grouped for display on the electronic paper display device (col. 16, lines 60-64) to assist the user in drawing on the writing surface over a selected one of the plurality of reference images (col. 14, lines 47-61 and col. 16, lines 48-68). Examiner understands that an image comprised by an interactive series of images being downloaded and displayed on the drawing screen is, or at

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least requires, a user interface device. Further, considering that the interactive series of images are being grouped for display on a **drawing screen**, it is clear that when the user selects one of said interactive images, this image is a reference image that assist the user in drawing upon it. Although the term user interface device is not specifically mentioned, by definition, an image comprised by an interactive series of images is used by the user to select one of said series of interactive images on which the user has particular interest, for example, JPEG images, GIF images, etc. Therefore, it is inherent for Comiskey to have a user interface device.

Regarding claim 2, Comiskey teaches of the electronic paper display device comprising: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Regarding claim 3, Comiskey teaches that the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 4, Comiskey further teaches of a network interface device configured for communication with a communication network and wherein the image displayed on the electronic paper display is received via the communication network (col. 16, lines 48-52 and 60-67. Note that the communications device and appropriate logic circuitry used to download information from the web or, internet, requires a network interface).

Regarding claim 9, Comiskey further teaches of a scanning device configured to convert a document to an electronic image to be displayed on the electronic paper display device (col. 17, lines 2-6).

Regarding claim 10, further (see claim 1) Comiskey teaches of a method comprising the steps of providing an electronic paper display device (col. 13, lines 58-61); arranging a writing surface (Fig. 12b, reference character 129) in superimposed relationship with the electronic paper display device (col. 14, lines 47-61. Note that the protecting layer or coating is the superimposed writing surface); displaying on the electronic paper display device a plurality of reference images (col. 14, lines 47-61 and col. 16, lines 60-68. Any underlying image over which the user may write constitutes a reference image and a predefined image); and furthermore enabling a user to select a predefined image from the plurality of reference images for display on the electronic paper display device (col. 16, lines 60-68), where the predefined image (any underlying image over which the user may write constitutes a reference and a predefined image) assists the user in drawing on the writing surface over the predefined image displayed by the electronic paper display (col. 14, lines 47-61 and col. 16, lines 48-68): The arguments regarding claim 1 above are also applicable to claim 10.

Regarding claim 13, Comiskey further teaches than the electronic paper display employs electronic ink technology (col. 5, line 45).

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Regarding claim 16, Comiskey further teaches of scanning the image from a document (col. 17, lines 2-3).

Regarding claim 18, Comiskey further teaches that the electronic display device comprises: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Regarding claim 19, Comiskey, further, teaches (see claim 1) of a memory configured to store the plurality of reference images to be displayed on the electronic paper display device (see Comiskey, col. 16, lines 49-50 and col. 17, lines 2-6. A plurality of images are recalled from memory, or displayed).

Regarding claim 21, Comiskey, further, teaches (see claim 10) that the user interface device includes a graphical user interface displayed on the electronic paper (col. 16, lines 60-64) to enable a user to view and select from the electronic paper a predefined image (col. 14, lines 47-53 and col. 16, lines 60-64. Any underlying image over which the user may write constitutes a reference image and a predefined image) of the plurality of reference images stored in the memory (col. 16, lines 49-50 and col. 17, lines 2-6). Examiner understands that an image comprised by an interactive series of images (emphasis added) being downloaded and displayed on the drawing screen is, or at least requires, a graphical user interface. Although the term

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graphical user interface is not specifically mentioned, by definition, an image comprised by an interactive series of images is used by the user to select one of said series of interactive images on which the user has particular interest. Therefore, it is inherent for Comiskey to have a graphical user interface.

Regarding claim 22, Comiskey further teaches (see claim 10) of selecting the predefined image to be displayed on the electronic paper display device from a plurality of reference images (col. 14, lines 47-61 and col. 16, lines 60-68. Any underlying image over which the user may write constitutes a reference, or predefined, image) displayed on the electronic paper display (col. 16, lines 60-64).

Regarding claim 23, Comiskey further teaches (see claim 10) of downloading the predefined image to be displayed on the electronic paper display device (col. 16, line 60-68).

Regarding claim 25, Comiskey further teaches (see claim 10) of selecting the predefined image from a graphical user interface displaying the plurality of reference images (see col. 16, lines 60-68). Again, examiner understands that an image comprised by an interactive series of images (emphasis added) being downloaded and displayed on the drawing screen is, or at least requires, a graphical user interface. Although the term graphical user interface is not specifically mentioned, by definition, an image comprised by an interactive series of images (emphasis added) is used by the user to select one of said series of interactive images on which the user has

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particular interest, for example JPEG images, GIF images, etc. In conclusion, it is inherent for Comiskey to have a graphical user interface.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey.

Regarding claims 20 and 24, Comiskey does not precisely teach of hardware buttons corresponding to a predetermined image of the plurality of reference images stored in the memory.

However, Comiskey teaches of recalling images from memory and of downloading a series of interactive images (see col. 16, line 60-col. 17, line 6). To recall images from either a local memory device, or a server, software buttons (options) needs to be selected.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have either the hardware buttons, or software buttons, in the device of Comiskey because it is a well known choice of the user or manufacturer of the system to have software buttons, hardware buttons, or a combination of both, wherein the same result is obtained and one type of button can be substituted for the other.

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5. Claims 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey et al. (6,473,072) in view Chery et al (6,177,927).

Regarding claims 5, 14 and 15, Comiskey fails to teach that the reference, or predefined, image comprises a Cartesian plane, or a template of a flowchart.

Chery teaches of a reference image comprising a Cartesian plane, or a template of a flowchart:

Chery teaches of a large variety of background, or reference, or predefined, images over which a user may write on the writing surface which may include a spreadsheet, blueprints, text, graphs, graphics (see Chery, col. 24, lines 30-50). Also, Chery teaches that images for the background images can be created with graphics programs such as VISIO, CAD programs, or other programs used to make documents, and also, that the reference image can be an image from a webpage (see Chery, col. 24, line 62-col. 25, line 5, and col. 25, lines 33-43). Finally, Chery teaches of a Cartesian coordinate that is transposed on the writing surface; the corners of the monitor image area are defined as (0,0), (0,H), (W,0) and (W,H) (see Chery, Figs. 11B and 11C, and col. 49, lines 47-63)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a reference image showing a Cartesian plane, or template, as taught by Chery, in the device of Comiskey, so that the user can write a stroke on the writing surface and know the precise stylus location (see Chery, col. 49, line 66-col. 50, line 2). Also, it is well known in the art of graphics that a program such as CAD can be used to create any desired graphical image such as a Cartesian coordinate, a graph, flowchart, etc.

6. Claim 17 and 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey (see above) in view of applicant's admitted prior art (APA, hereafter).

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Regarding claim 17 and 26, Comiskey fails to teach of printing the image displayed on the electronic paper display and the contents of the writing surface.

APA teaches of printing the combined scan result of the predefined image displayed on the electronic paper display and the contents of the writing surface (see application, page 2, lines 2-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the combined image, as taught by APA, in the device of Comiskey because it is well known in the art of electronic whiteboards to integrate a printer which can print both original images and updated images, for example, to provide an updated hard copy of the lecture or conference to all the participants.

Response to Arguments

7. Applicant's arguments filed 5-11-2005 have been fully considered but they are not persuasive.

Regarding independent claims 1 and 10, applicant provided the following arguments:

First, applicant argues that, in Comiskey, the context for interactive series of images is web browsing, and not selecting one of the images to be drawn upon.

Examiner disagrees because, in addition to arguments provided in previous Office Actions, Comiskey teaches of a drawing device with the display being a drawing screen (col. 16, lines 60-68). Therefore, any selected image can be drawn upon by the user.

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Next, applicant argues that Comiskey does not teach that a plurality of images are presented on the display together.

Examiner disagree because, in addition to arguments provided in previous Office Actions, Comiskey very clearly teaches that “an image”, or “the image” can be “an interactive series of images” (col. 16, lines 60-64), not images displayed consecutively “in series”, as suggested by applicant. “The image” comprising an interactive series of images is interpreted by the examiner as a group, or set, of images that presented together on the display form “an image”. This group, or series of images, being “interactive” clearly means that any of the images displayed together can be independently selected to be increased in size to be seen in more detail. This images can be separate, as a set of photos, or can be parts or pieces of a picture that, when independently selected, can be increased in size to provide more detail, for example, Mpeg, Jpeg, etc.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is 703 305-2248. The examiner can normally be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala whose telephone number is 703 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

703 872-9306 (for Technology Center 2600 only)

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ricardo L. Osorio
Examiner
Art Unit: 2673

RLO
May 23, 2005